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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/529,990 | 04/24/2000 | KENICHI NAKAMA | Q58939 | 7259 |

7590 04/18/2002

SUGHRUE MION ZINN
MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20037

EXAMINER

CHEVALIER, ALICIA ANN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

8

DATE MAILED: 04/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary

Applicati n N .

09/529,990

Applicant(s)

NAKAMA ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-12 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that restriction is improper. This is not found persuasive because special technical feature in Group I, a multiplayer-coated substrate comprising two or more superposed layers, which comprise an organopolysiloxane, and the outermost layer of which has projections, is not found in group II. Further more the special technical features of Group I does not define a contribution over the prior art as by evidence by Andras '596 in the below art rejections.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claims 4-7, 9, 11, and 12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-7, 9, 11, and 12 have not been further treated on the merits.

3. Claim 4 is objected to because of the following informalities: "wherein in" in line 2.

Appropriate correction is required.

4. Claim 5 is objected to because of the following informalities: "wherein in" in line 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Andrus (5,212,596).

Andrus discloses a nonreflective article comprising an outer layer with angle projections, an inner layer, and a substrate (figure 3). Both the outer layer and inner layer preferably comprise silicone (organopolysiloxane) (col. 5, lines 5-10). The height of the pyramids or ridges is typically less than 250 microns (col. 6, lines 36-37). Where the inner and outer layer are from about 10 to 250 microns (claims 6 and 7).

Claim Rejections - 35 USC § 102/103

7. Claim 5 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andrus (5,212,596).

Although Andrus does not explicitly teach the limitations the coefficients of linear expansion of the respective layers change gradationally from the substrate toward the outermost layer, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. organopolysiloxane) used to produce the nonreflective article. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed coefficient of linear expansion would obviously have been provided by the process disclosed by Andrus. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

8. Claims 1-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takematsu et al. (6,207,263).

Takematsu discloses an anti-reflection film comprising a transparent base film, a hard coat layer with angled projections, and an intermediate refractive index layer (figure 2). The hard coat layer and intermediate refractive index layer may comprise organosilicon (organopolysiloxane) compounds such as tetraethoxysilane or methyltriethoxysilane (col. 6, lines 35-52). The thickness of the hard coat layer is preferably 0.5 to 6 micrometers (col. 6, lines 53-54). Even though Takematsu is silent about the height of the projections, when the hard coat layer is between 0.5 and 1 micrometer the projections cannot have a height greater than 1 micrometer.

Art Unit: 1772

Although Takematsu does not explicitly teach the limitations the coefficients of linear expansion of the respective layers change gradationally from the substrate toward the outermost layer, the relationships set forth in claims 9 and 10, and wherein the transmitted light has a wavelength from 380 to 2000 nm, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. organopolysiloxane) used to produce the anti-reflection film. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed coefficient of linear expansion, relationships, and transmitted light would obviously have been provided by the process disclosed by Takematsu. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Blaine Copenheaver can be reached by dialing (703) 308-1261. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

4/16/02


DEBORAH JONES
SUPERVISORY PATENT EXAMINER